

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YEVGENIY EUGENE SHTEYN

Appeal 2007-1568
Application 09/900,375
Technology Center 2800

Decided: October 1, 2007

Before KENNETH W. HAIRSTON, JEAN R. HOMERE, and
ST JOHN COURTENAY, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1 through 13. We have jurisdiction under 35 U.S.C. § 6(b) to decide this appeal. We affirm.

The Invention

Appellant invented a portable clock having a programmable graphical user interface (GUI) to indicate specific time slots allocated to a user's personal scheduled activities. (Specification 1).

An understanding of the invention can be derived from exemplary independent claim 1, which reads as follows:

1. An electronic device with a timepiece having a dial face that comprises a display monitor for providing a graphical representation of a scheduled activity associated with a time of day segment displayed on the dial face.

In rejecting the claims on appeal, the Examiner relies upon the following prior art:

Nixon	US 6,033,316	Mar. 7, 2000
Hepp	US 6,449,219 B1	Sep. 10, 2002
Narayanaswami	US 6,477,117 B1	Nov. 5, 2002

The Examiner rejects the claims on appeal as follows:

- A. Claims 1, 5, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hepp.
- B. Claims 2 through 4, 6, 7, 12, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Hepp and Nixon.
- C. Claims 9 through 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination Hepp and Narayanaswami.

Regarding the above rejection, Appellant contends¹ that Hepp does not fairly teach or suggest a dial face that displays a graphical representation of a scheduled activity associated with a time of day segment displayed on the dial face, as recited in claim 1. (Br. 5-7.) In response, the Examiner contends that Hepp's disclosure of an optoelectronic display including a figurative character and a timepiece renders the claimed invention unpatentable. (Answer 3-7.)

ISSUE

The *pivotal* issue in the appeal before us is as follows:
Has Appellant shown² that the Examiner failed to establish that the disclosure of Hepp renders the claimed invention unpatentable under 35

¹ This decision considers only those arguments that Appellant submitted in the Appeal Brief. Arguments that Appellant could have made but chose not to make in the Brief are deemed to have been waived. *See* 37 C.F.R. § 41.37(c)(1) (vii) (eff. Sept. 13, 2004). *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

² In the examination of a patent application, the Examiner bears the initial burden of showing a *prima facie* case of unpatentability. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When that burden is met, the burden then shifts to the applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44, 74 USPQ2d 1951, 1954-55 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the applicant produces rebuttal evidence of adequate weight, the *prima facie* case of unpatentability is dissipated. *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Thereafter, patentability is determined in view of the entire record. *Id.* However, Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998)).

U.S.C. § 103(a)? Particularly, does Hepp's disclosure of an optoelectronic display with a figurative character and a timepiece render unpatentable Appellant's timepiece with a dial face for graphically representing thereon a scheduled activity associated with a particular time?

FINDINGS OF FACT

The following findings of fact are supported by a preponderance of the evidence.

The Invention

1. Appellant invented a timepiece (100) with a dial face (102), which includes a display monitor (108) that can be programmed to form segments that graphically represent time slots (110, 112, 114, and 116) allocated to scheduled activities of a user's personal calendar. (Specification 3.)
2. The length of each segment designates the duration of the activity while the color of the segment indicates the type of activity. (*Id.*)

The Prior Art Relied Upon

3. Hepp teaches an optoelectronic display (1) for dynamically representing information related to the course of time. (Col. 4, ll. 51-54.)
4. As depicted in Figure 1, Hepp's display device (1) includes the time of day (14), the position of the sun (6), the moon (8), selected stars (7), and the horizon (5). (Col. 5, ll.1-4.)
5. The display device (1) also includes a timepiece with a computer based clock (2). (Col. 5, ll. 12-13.)

6. The timepiece in turn includes a dial face (3) that displays objects (11, 12, and 13), typical of the current season, that are associated with a treetop (10), (Col. 5, ll. 15-19).
7. The objects are displayed on the dial face of the clock (2) to represent the specific season according to the changes with time of the treetop (10) during the course of the year. (Col. 5, ll. 8-10).
8. Hepps' display device further includes a figurative character (15) that reminds users of the jobs to be done depending on the time and location. (Col. 5, ll. 24-30).

PRINCIPLES OF LAW

1. OBVIOUSNESS (Prima Facie)

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), stated that three factual inquiries underpin any determination of obviousness:

Under § 103, [1] the scope and content of the prior art are to be determined; [2] differences between the prior art and the claims at issue are to be ascertained; and [3] the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Where the claimed subject matter involves more than the simple substitution one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding

of obviousness must be based on “an apparent reason to combine the known elements in the fashion claimed.” *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). That is, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Such reasoning can be based on interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art. *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396.

ANALYSIS

35 U.S.C. § 103(a) REJECTION

Claims 1, 5, and 8

As set forth above, independent claim 1 requires a dial face that displays a graphical representation of a scheduled activity associated with a time of day segment displayed on the dial face. We find that Hepp substantially teaches that limitation. As detailed in the Findings of Fact section above, we have found that Hepp teaches a dial face of a timepiece that graphically depicts thereon objects to represent a particular season associated with changes in a treetop over time during the course of a year. (Findings 6-7). We have also found that Hepp further teaches a figurative character for providing users with a visual reminder of jobs to be done at different times during the course of a day. (Finding 8). It is our view that one of ordinary skill in the art would have readily recognized that Hepp’s

disclosure of displaying objects in the dial face to represent seasonal changes teaches Appellant's claimed graphical representation of a scheduled activity displayed on the dial face. Particularly, the ordinarily skilled artisan would have readily appreciated that season changes occur over definite periods of time in the course of the year. Therefore, a season change can accordingly be programmed in the clock as an activity or event scheduled to occur (as depicted on the tree top) at a particular time in the course of the year.

Further, the ordinarily skilled artisan would have readily recognized that Hepp's teaching of a figurative character teaches Appellant's claimed scheduled activity associated with a time of day segment. Claims are to be given their broadest reasonable interpretation during prosecution, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005) (en banc). Appellant could have amended the claim consistent with how Appellant wants the claim to be interpreted. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." *In re Zletz*, 893 F.2d at 322, 13 USPQ2d at 1322.

As rightfully argued by Examiner in the Answer (4), the ordinarily skilled artisan would have readily appreciated that a time of day segment is

not limited to a *physical* representation of a time segment in the dial face. Broadly construed, it can also be interpreted as being any portion, duration, or period of time (in the dial face) in the course of a day (during which an event/activity is scheduled to occur). We therefore, favor the Examiner's broader construction of the limitation "time of day segment" over Appellant's narrower definition, which has no basis in the claim. Additionally, we agree with the Examiner, as properly argued in the Answer (7), that the ordinarily skilled artisan would have readily appreciated that users cannot be reminded of jobs to be done if such jobs were not previously scheduled. Thus, Hepp's disclosure of reminding users of jobs to be done at particular time periods in the course of a day teaches the claimed scheduled activities associated with time of day segments.

In light of these findings, we conclude that Hepp's teachings of displaying objects in the dial face to depict seasonal change, coupled with the teaching of reminding users of jobs to be done in the course of a day would have predictably led the ordinarily skilled artisan to graphically represent on the dial face a scheduled activity associated with a time of day segment. It has been held that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). It follows that the Examiner did not err in rejecting claim 1 as being unpatentable over Hepp. We affirm this rejection.

Appellant did not provide separate arguments with respect to the rejections of claims 5 and 8. Therefore, we select independent claim 1 as being representative of these claims. Claims 5 and 8 consequently fall

together with representative claim 1. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

Claims 2-4, 6-7 and 12-13

Appellant reiterates the above arguments with respect to the rejection of claims 2 through 4, 6, 7, 12 and 13, as being unpatentable over the combination of Hepp in view of Nixon. (Br. 13.) As discussed in the preceding section, we do not find any such deficiencies in Hepp for Nixon to remedy. Hepp teaches the scheduled activities.

Further, Appellant alleges that there is no motivation to combine the references. (*Id.*) We note that Appellant's mere allegations, unsupported by any evidence, do not amount to an argument that particularly shows how the Examiner's reliance on the cited combination of Hepp and Nixon does not render the cited claims unpatentable. In our view, such allegations do not rebut the Examiner's prima facie case of obviousness against the cited claims. We therefore affirm this rejection.

Claims 9-11

Appellant reiterates the above arguments with respect to the rejection of claims 9 through 11 as being unpatentable over the combination of Hepp in view of Narayanaswami. (Br. 14.) As discussed in the preceding section, we do not find any such deficiencies in Hepp for Narayanaswami to remedy. Further, Appellant alleges that there is no motivation to combine the references. (*Id.*) We note that Appellant's mere allegations, unsupported by any evidence, do not amount to an argument that particularly shows how the Examiner's reliance on the cited combination of Hepp and Narayanaswami

fails to render the cited claims unpatentable. In our view, such allegations do not rebut the Examiner's prima facie case of obviousness against the cited claims. We therefore affirm this rejection.

CONCLUSION OF LAW

On the record before us, Appellant has not shown that the Examiner failed to establish that Hepp renders claims 1, 5, and 8 unpatentable over Hepp. Similarly, Appellant has not shown that the Examiner failed to establish that claims 2 through 4, 6, 7, 12, and 13 are unpatentable over the combination of Hepp and Nixon under 35 U.S.C. § 103(a). Additionally, Appellant has not shown that the Examiner failed to establish that claims 9 through 11 are unpatentable over the combination of Hepp and Narayanaswami under 35 U.S.C. § 103(a).

DECISION

We have affirmed the Examiner's decision rejecting claims 1 through 13.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2007-1568
Application 09/900,375

AFFIRMED

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR NY 10510